

REMARKS/ARGUMENTS

This is in response to an Office Action dated August 21, 2007 wherein Claims 1, 4-19, 29-34, 36, 38, 43 and 45-47 were rejected for being directed to non-statutory subject matter. The Examiner stated that merely "performing the checking, the copying and the creating" by processor, do not provide any tangible result and practical real world application. See bottom of page 3 of the Office Action.

This statement is respectfully traversed for several reasons. Note that the Examiner failed to follow MPEP §2106 IV B which contains the following requirement "If the invention as set forth in the written description is statutory, but the claims define subject matter that is not, the deficiency can be corrected by an appropriate amendment of the claims. In such a case, USPTO personnel should reject the claims drawn to nonstatutory subject matter under 35 U.S.C. 101, but identify the features of the invention that would render the claimed subject matter statutory if recited in the claim."

In the current Office Action, the Examiner did not identify any features of the Applicant's invention that would render any claim statutory. Accordingly, if the Examiner rejects any claim in future under 35 U.S.C. 101, the Examiner is requested to follow the MPEP, i.e. identify features that would render the claimed subject matter statutory.

Claim 1 is not an idea or concept, and instead it is a method that requires processes within a computer. Computer processes are "real world" entities because they exist in a computer and the computer itself is a real world entity.

Moreover, Claim 1 now explicitly requires a storage media (for support see page 4 at lines 22-26), and further requires that at least one item in the plurality of items is copied to that storage media. For additional support see FIG. 1A. It is readily apparent that the state of the "storage media" is changed by Claim 1, from before Claim 1's copying, to after Claim 1's copying. Specifically, Claim 1's "copying" provides a transformation of an article, namely the storage media, to a different state. Transformation of a storage media has "real world" value which indicates that Claim 1 is patentable.

In this context, the Examiner's attention is drawn to the Examiner guidelines in a section entitled "Practical Application by Physical Transformation", MPEP §2106 IV C 2 (1) which states in pertinent part "USPTO personnel first shall review the claim and determine if it provides a transformation or reduction of an article to a different state or

thing. If USPTO personnel find such a transformation or reduction, USPTO personnel shall end the inquiry and find that the claim meets the statutory requirement of 35 U.S.C. 101."

Hence, the Examiner must first consider whether Claim 1 provides a transformation of storage media to a different state, and only if the Examiner is convinced that this requirement is not satisfied the Examiner may proceed to the "tangible result" requirement.

Claim 1's storage media is not only transformed, but Claim 1 does meet each of three requirements: useful, concrete and tangible, for the following reasons. Specifically, Claim 1's storage media which contains the copied item is "useful," because the copied item can be retrieved therefrom. Moreover, Claim 1's storage media is "tangible" because it is a real world device which is not "abstract", i.e. it is not a law of nature or a mathematical formula. Finally, Claim 1's storage media is itself a concrete result, because it can be used to retrieve the copied item (for example, see the original specification at page 1, line 9). Furthermore, Claim 1's act of copying can be performed repeatedly, which is another indication that Claim 1's method provides a concrete result.

Accordingly, Applicant respectfully submits that Claim 1 is not directed to non-patentable subject matter. Hence, Applicant respectfully requests the Examiner to withdraw the §101 rejection of independent Claim 1 and of Claims 4-19 and 34, 36, 38, 39, 46 and 47 that depend from Claim 1.

Moreover, independent Claims 29 and 43 are also believed to be patentable for reasons similar to those discussed above for Claim 1. Hence, Applicant respectfully requests the Examiner to withdraw the §101 rejection of independent Claims 29 and 43 and their dependent claims 30-33 and 45 respectively.

In view of the above remarks, Applicant submits that all pending claims should now be allowed. Please call the undersigned at (408) 378-7777, ext 113 in case of questions.

Respectfully submitted,



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